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EXAMINER

WORJLOH, JALATEE

ART UNIT

PAPER NUMBER

3621

DATE MAILED: 05/08/2003

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/693,890

Applicant(s)

TSUR ET AL.

Examiner

Jalatee Worjoh

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

1) Responsive to communication(s) filed on ____.

2a) This action is FINAL. 2b) This action is non-final.

3) Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

4) Claim(s) 1-21 is/are pending in the application.

4a) Of the above claim(s) ____ is/are withdrawn from consideration.

5) Claim(s) ____ is/are allowed.

6) Claim(s) 1-21 is/are rejected.

7) Claim(s) 1 is/are objected to.

8) Claim(s) ____ are subject to restriction and/or election requirement.

Application Papers

9) The specification is objected to by the Examiner.

10) The drawing(s) filed on ____ is/are: a) accepted or b) objected to by the Examiner.

Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

11) The proposed drawing correction filed on ____ is: a) approved b) disapproved by the Examiner.

If approved, corrected drawings are required in reply to this Office action.

12) The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. §§ 119 and 120

13) Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).

a) All b) Some * c) None of:

1. Certified copies of the priority documents have been received.

2. Certified copies of the priority documents have been received in Application No. ____.

3. Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

14) Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).

a) The translation of the foreign language provisional application has been received.

15) Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

Attachment(s)

1) Notice of References Cited (PTO-892)

2) Notice of Draftsperson's Patent Drawing Review (PTO-948)

3) Information Disclosure Statement(s) (PTO-1449) Paper No(s) ____.

4) Interview Summary (PTO-413) Paper No(s). ____.

5) Notice of Informal Patent Application (PTO-152)

6) Other: ____.

DETAILED ACTION

1. Claims 1-21 have been examined.

Information Disclosure Statement

2. The listing of references in the specification is not a proper information disclosure statement. 37 CFR 1.98(b) requires a list of all patents, publications, or other information submitted for consideration by the Office, and MPEP § 609 A(1) states, "the list may not be incorporated into the specification but must be submitted in a separate paper." Therefore, unless the references have been cited by the examiner on form PTO-892, they have not been considered.

Claim Objections

3. Claim 1 is objected to because of the following informalities: applicant must define "BIN" in claim 1; that is change "BIN" to "Bank identification number (BIN)". Appropriate correction is required.

Claim Rejections - 35 USC § 101

4. 35 U.S.C. 101 reads as follows:

Whoever invents or discovers any new and useful process, machine, manufacture, or composition of matter, or any new and useful improvement thereof, may obtain a patent therefor, subject to the conditions and requirements of this title.

Claims 1,12,13,14, and 21 are rejected under 35 U.S.C. 101 because the claimed invention is directed to non-statutory subject matter. That is, claim 12 and 21 are not explicitly in the technological arts. The body of the claims must comprise a hardware.

Claim Rejections - 35 USC § 102

5. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

6. Claims 1-10, 12-14, 17-21 are rejected under 35 U.S.C. 102(e) as being anticipated by U.S. Patent No. 6330544 to Walker et al.

Walker et al. disclose generating a proxy number in a client user interface software to be used in place of a credit card number in a transaction, associating said proxy number with a financial account number (see abstract, lines 5-8; col. 7, lines 36-45; col. 8, lines 22-24), generating a transaction number which comprises a BIN, a proxy number and a checksum digit (see col. 7, lines 55-67; col. 8, lines 1-21), and transmitting said transaction number to a merchant in place of an actual credit card number (see abstract, lines 9-10).

Referring to claims 2-4, Walker et al. disclose said transaction number is an identical format to a conventional credit card number, has sixteen digits, and said customer financial account is a credit card (see col. 7, lines 55-67; col. 8, line 1).

Referring to claims 5 and 6, Walker et al. disclose said financial account is a debit card (see col. 6, lines 55-67; col. 7, lines 1-3). As per the step wherein said debit card has greater than sixteen digits, this is an obvious step. That is, it is conventional for debit cards to have more than sixteen digits.

Referring to claims 7 and 9, Walker et al. disclose said financial account is a master credit card account (see col. 6, lines 55-67; col. 7, lines 1-3). Note. Walker et al. indicates that the account used may be “any account that may be identified...”; thus, “any account” may include a master credit card account or a wireless account.

Referring to claim 8, Walker et al. disclose the associating said master financial account with an individual customer account (see abstract, lines 5-9; col. 8, lines 22-24).

Referring to claim 10, Walker et al. disclose receiving at a central server an authorization request for a transaction number from a card association network, wherein said authorization request includes a retrieval reference number, associating said transaction number with said retrieval reference number, generating an authorization reply in response to said authorization request, and transmitting said authorization reply to an address identified by said retrieval reference number (see col. 9, lines 40-67; col. 10, lines 1-11).

Referring to claim 12, Walker et al. disclose generating a proxy transaction number having form five to ten digits, appending to said proxy number, prior to the first digit ins aid proxy number a bank identification number having form four to tend digits and appending after the last digit of said proxy transaction number a checksum digit (see abstract, lines 5-8; col. 7, lines 55-67; col. 8, lines 1-24). Note. Walker et al. disclose generating a redemption voucher identifier that comprises a BIN having four to ten digits, proxy transaction number and last checksum digits. Although Walker et al. do not explicitly state that the numbers/digits were appended, these are inherent steps. That is, the proxy number, Bin and checksum must have been appended prior to the generation of the “redemption voucher identifier” (i.e. “transaction

number"). Hence, appending the proxy number, Bin and checksum are prerequisites for generating the transaction number.

Referring to claim 13, Walker et al. disclose generating a proxy number having from five to ten digits (see abstract, lines 5-8), creating a record in a cross reference database having first and second data fields, inserting into said first data field said proxy transaction number, and inserting into said second data field a customer's actual financial account number, wherein said first data field and said second data field have an unequal number of digits and are related for cross referencing (see fig. 6; col. 13, lines 45-67; col. 14, lines 1-6).

Referring to claims 14 and 17, Walker et al. disclose generating a transaction number, creating a record in a transaction number usage limitations database having at least one field for storing said proxy transaction numbers and having at least one date field for storing a transaction number usage limitation, wherein said transaction number usage limitation is a maximum purchase amount (see fig. 6, col. 13, lines 2-6).

Referring to claims 18-20, Walker et al. disclose receiving at a central server a request to authorize a transaction number, retrieving from a transaction number usage limitation database a record containing at least one transaction number usage limitation which refers to said transaction number, comparing said transaction number usage limitation to said authorization request and determining whether said authorization request falls within the limitations contained in the transaction number usage limitation, sending a negative authorization response to a merchant if said authorization request does not meet said transaction number usage limitation (see col. 9, lines 40-67; col. 10, lines 1-11).

Claim Rejections - 35 USC § 103

7. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

8. Claims 11 and 21 are rejected under 35 U.S.C. 103(a) as being unpatentable over Walker et al. in view of 5883810 to Franklin et al.

Walker et al. disclose generating a proxy number, generating a transaction number comprising said proxy number, wherein said transaction number has 16 digits, associating said transaction number with the customer account number and transmitting said transaction number to a merchant in place of a credit card number (see abstract, lines 5-8; col. 7, lines 36-45; col. 8, lines 22-24). Walker et al. do not expressly disclose a wireless device. Franklin et al. disclose a user of a wireless device (see col. 3, lines 49-63). At the time the invention was made, it would have been obvious to a person of ordinary skill in the art to modify the method disclosed by Walker et al. by including a wireless device. One of ordinary skill in the art would have been motivated to do this because it supports mobile transactions.

Referring to claim 21, Walker et al. disclose generating a transaction number having a format identical to a conventional credit card number, associating said transaction number with a customer debit account number (see abstract, lines 5-10; col. 6, lines 55-67; col. 7, lines 1-3), submitting said transaction number to a merchant in connection with the purchase of goods and services, receiving from said merchant an authorization request for said proxy transaction number, determining whether the amount of funds available in said customer debit card account

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exceed the purchase amount specified in said authorization request, (see col. 9, lines 40-67; col. 10, liens 1-11; col. 6, lines 66-67; col. 7, lines 1-5). As per the step of transferring from said customer debit card account to a transitory debit account an amount of money equal to said purchase amount specified in said authorization request, this is an inherent step. Walker et al. do not expressly disclose associating said transaction number with a debit account PIN number. Franklin et al. disclose associating said transaction number with a debit account PIN number. (see col. 6, lines 50-60). At the time the invention was made, it would have been obvious to a person of ordinary skill in the art to modify the method disclose by Walker et al. to include the step of disclose associating said transaction number with a debit account PIN number. One of ordinary skill in the art would have been motivated to do this because it provides additional security (see Franklin et al. col. 2, lines 48-55).

9. Claims 15 and 16 are rejected under 35 U.S.C. 103(a) as being unpatentable over Walker et al. as applied to claim 14 above, and further in view of Franklin et al.

Walker et al. disclose a transaction number usage limitation database storing a transaction number usage limitation (see fig. 5; col. 13, lines 2-6). Walker et al. do not expressly disclose the usage limitation is a single use. Franklin et al. disclose the usage limitation is a single use (see abstract, lines 9-11). One of ordinary skill in the art would have been motivated to modify the method disclose by Walker et al. to include the step wherein the usage limitation is a single use. One of ordinary skill in the art would have been motivated to do this because "it reduces or eliminates the incentive for stealing credit card data." (see Franklin, col. 1, lines 46-50).

Referring to claim 16, Walker et al. disclose a transaction number usage limitation database storing a transaction number usage limitation (see fig. 5; col. 13, lines 2-6). Walker et

al. do not expressly disclose the usage limitation is a specific merchant identifier. Franklin et al. disclose the usage limitation is a merchant identifier (see col. 2, lines 50-52). One of ordinary skill in the art would have been motivated to modify the method disclosed by Walker et al. to include the step wherein the usage limitation is a merchant identifier. One of ordinary skill in the art would have been motivated to do this because it provides additional security (see Franklin col. 2, lines 44-52).

Conclusion

10. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.

US Patent No. 6422462 to Cohen disclose apparatus and methods for improved credit cards and credit card transactions.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Jalatee Worjloh whose telephone number is 703-305-0057. The examiner can normally be reached on Mondays-Thursdays 8:30 - 7:00.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, James Trammell can be reached on 703-305-9768. The fax phone numbers for the organization where this application or proceeding is assigned are 703-305-7687 for regular communications, 703-746-9443 for Non-Official/Draft and 703-305-7687 for After Final communications.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is 703-308-1113.

Any response to this action should be mailed to: **Commissioner of Patents and Trademarks,
Washington, DC 20231.**

Hand delivered responses should be brought to Crystal Park 5, 2451 Crystal Drive,
Arlington, V.A., Seventh floor receptionist.

January 23, 2003

John W. Hayes
John W. Hayes
Primary Examiner